

REMARKS

Claims 1, 3, 8-12, 14-16, 20 and 21 are pending in this application. By this Amendment, claims 1, 3, 8, 12 and 14 are amended; claims 6, 7, and 13 are canceled; and claims 20 and 21 are added. Support for the amendments to the claims and new claims may be found, for example, in the original claims and in the specification at page 5, line 3 to page 10, line 4. No new matter is added. In view of the foregoing amendments and the following remarks, reconsideration and allowance are respectfully requested.

III. Interview

The courtesies extended to Applicants' representative by Examiner Hobbs at the interview held January 22, 2009, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicants' record of the interview. In regards to the interview, Applicants have not received the interview summary from the Patent Office and note that a copy is not available on PAIR. Accordingly, Applicants respectfully request a copy of the Interview Summary be mailed to Applicants' representatives at the address set forth below.

In addition, during the interview the abbreviation "McF" was discussed. Applicants confirm that McF is the abbreviation for McFarland, which is a unit for the optical density of a microbial suspension.

III. Claim for Priority

Applicants thank the Examiner for the note regarding the absence of a certified copy of the French patent application. Applicants understand the certified copy of the foreign application specified in 35 U.S.C. §119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted. See 37 CFR §1.55(2). Accordingly, Applicants will file a certified copy of the French patent application in due course.

III. Rejection under 35 U.S.C. §112, Second Paragraph

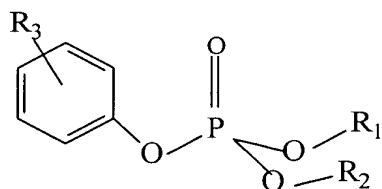
The Office Action rejects claims 3 and 6-11 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. By this Amendment, claims 6 and 7 are canceled, rendering their rejection moot, and claim 3 is amended in light of the Examiner's comments. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Response to Claim Rejections Based on 35 U.S.C. §103

The Office Action rejects claims 1, 3, and 6-16 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,854,011 to Chen et al. (hereinafter "Chen") in view of Cooke et al. ((1999) Appl. Env. Microbial. 65(2): 807-812) (hereinafter "Cooke"), Kardos et al. ((2000) Toxicological Sciences 58: 118-126), Sondegaard et al. ((2001) Chem. Eng. 7(11): 2324-2331), Merrer et al. ((1997) Bioorg. Med. Chem. 5(3): 519-533) and Gilbert et al. (WO 2002/40706). By this Amendment, claims 6, 7, and 13 are canceled, rendering their rejection moot. As to the remaining claims, Applicants respectfully traverse the rejection.

Without conceding the propriety of the rejection, claim 1 is amended to incorporate the subject matter of canceled claims 6 and 7 and claim 12 is recast in independent form and amended to incorporate the subject matter of claim 13. Specifically, claims 1 and 12 are amended to recite in-part:

1. ...at least one substrate that can be hydrolysed to a labelled product by an esterase not free in the sample, and specific for said bacterium, and
 at least one inhibitor of at least a second enzyme, different from the first enzyme or identical to it, but free in said sample and not originating from said bacterium,
 wherein the inhibitor is a compound of formula (I)

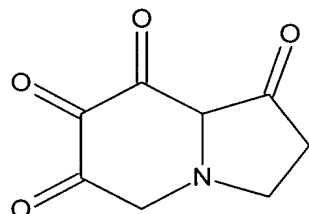


in which R₁ is a hydrogen atom, or an alkyl, aryl or halogen group,
R₂ is a hydrogen atom, or an alkyl, aryl or halogen group,
R₃ is nothing, or an alkyl, aryl or NO₂ group.

12. ...at least one substrate that can be hydrolysed to a labelled product by an osidase not free in the sample, and specific for said bacterium, and

at least one inhibitor of at least a second enzyme, different from the first enzyme or identical to it, but free in said sample and not originating from said bacterium,

wherein the inhibitor is a compound of formula (II):



(II)

or a derivative of this compound.

The applied references fail to teach or suggest or establish any reason or rationale to provide such a combination of features, as recited in claims 1 and 12.

The Office Action acknowledges Chen does not disclose esterases, osidases or use of esterase or osidase inhibitors (see Office Action, page 5); Cook does not disclose osidases or use of esterase or osidase inhibitors (see Office Action, page 5); and Kardos does not disclose chromogenic media and osidases. See Office Action, page 5. Sondegaard and Merrer do not disclose chromogenic media or the *in vivo* use of inhibitors. See Office Action, page 5.

Nowhere does the Office Action point to any part of the applied references that teaches or suggests or establishes any reason or rationale to provide such a combination of features, as recited in claims 1 and 12.

Therefore, with regards to the subject matter of previous claims 1 and 12 (previously claims 6, 7, 12, and 13) the current rejections are improper because the Office Action fails to provide a clear articulation of the rejection. MPEP § 2143 states that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed

invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit” (emphasis added). The Office Action has not made such a clear articulation, and must do so in order to continue to support the claim rejections.

Additionally, the proposed combination of Chen and the other applied references is improper because the combination renders Chen unsatisfactory for its intended purpose of measuring yeast and mold concentration due to the interference provided by enzymes produced by bacteria. See MPEP §2143.01(V). Furthermore, the proposed combination of Chen and the other applied references is improper because the proposed combination changes the principle of operation of Chen by requiring the exclusion of one or more antibiotics specific for inhibiting growth of heterotrophic bacteria. MPEP §2143.01(VI). Accordingly, claims 1 and 12 would not have been obvious over Chen and the other applied references because there is no reason for one of ordinary skill in the art to make such a combination.

Thus, for at least the reasons presented above, claims 1 and 12 and their dependent claims would not have been rendered obvious by the applied references. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. New Claims

By this Amendment, new claims 20 and 21 are presented. New claims 20 and 21 depend from claims 1 and 12, respectively, and thus, distinguish over the applied references for at least the reasons discussed above with respect to claims 1 and 12. Prompt examination and allowance of new claims 20 and 21 are respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



William P. Berridge
Registration No. 30,024

Benjamin S. Prebyl
Registration No. 60,256

WPB:BSP

Date: February 17, 2009

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--